

REMARKS/ARGUMENTS

Favorable consideration of this Application and in light of the following discussion is respectfully requested.

Claims 1-20 are pending in the present Application Claims 15-20 being currently withdrawn. Claims 1, 2, 5, 6, 8, 9 and 12 are amended by the present response. Thus, no new matter has been added.

By way of summary, the Final Official Action presents the following issues: Claims 1-14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Stefik et al. (U.S. Patent No. 5,629,980, herein Stefik).

The Official Action has rejected Claims 1-14 under 35 U.S.C. § 102(b) as being anticipated by Stefik. The Official Action asserts that Stefik discloses all of the Applicant's claim limitations. Applicants respectfully traverse the rejection.

M.P.E.P. §2131 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,"(emphasis added). Further, M.P.E.P. §2143.03 states that "all words in a claim must be considered in judging the patentability of that claim against the prior art."

As noted in Applicants response filed on January 10, 2006 Stefik does not disclose or suggest combining content based on whether or not the content has been previously transferred to an apparatus connected to an information processor, as recited in Applicants Claim 1.

Claim 1 recites, in part, "combining the first and second contents together when it is determined by the first and second judging means that neither the first nor second content has been transferred to an apparatus connected to the information processor."

Stefik does not describe or suggest judging if content has been transferred to an apparatus connected to the information processor. Although, Col. 31, line 63 through col. 32,

line 18 of Stefik describe “loaning out” a digital work and describes composite digital works in col. 18, Stefik does not describe combining two works when it is determined that neither work has been transferred to an apparatus connected to the information processor.

Further, Applicants and Applicants’ representatives thank Examiner Pond for the courtesy of the discussion conducted on August 17, 2006. In the discussion, Examiner Pond indicated that an Advisory Action was forthcoming in the present application. Further it was indicated that the Stefik reference inherently teaches limiting a work from being transferred as Stefik describes that the system cannot grant more rights that it has for a specific work, including a combination work. In response, as is discussed above, Applicants submit that Stefik does not describe or suggest that determining that neither a first nor second content has been transferred to an apparatus connected to the information processor.

Additionally, the outstanding Office Action, in the section entitled “Response to Arguments”, states that “it is common business proactive to combine documents to create a composite work. If, for example; an unclassified document is combined with a confidential document, then the composite document usage is classified as confidential...For instance, if a non-confidential document [is] placed into a client’s confidential case file (i.e. a composite work), then subsequent usage of that particular non-confidential document requires a confidential usage right. I’m confident that this is typical practice at a law office.” However, Applicants fail to see how this supports that assertion that Stefik anticipates all of the features of the present invention as recited in the claims as is required in a §102 rejection. For instance, Stefik does not describe or suggest determining that neither a first nor second content has been transferred to an apparatus connected to the information processor.

Accordingly, as Stefik does not describe every feature of the present invention as recited in Claim 1, Claim 1 patentably distinguishes over Stefik.

Additionally, Claims 5, 8 and 12 similarly recite the above noted features of Claim 1 and the arguments presented above also apply to these claims and claims depending therefrom.

Therefore, it is respectfully submitted that independent Claims 1, 5, 8 and 12 and any claims depending therefrom, patentably distinguish over the teachings of Stefik.

Accordingly, Applicants respectfully request that the final rejection of Claims 1-14 under 35 U.S.C. § 102 be withdrawn.



Consequently, in view of the foregoing remarks, it is respectfully submitted that the present Application, including Claims 1-14, is patently distinguished over the prior art, in condition for allowance, and such action is respectfully requested at an early date.

Respectfully submitted,

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